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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,537	08/28/2003	Gregory G. Kuelbs	0638MH-40982-US	9033

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EXAMINER

SAWHNEY, HARGOBIND S

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/650,537	Applicant(s) KUELBS, GREGORY G.	
	Examiner Hargobind S. Sawhney	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-25, 30, 33, 34 and 70-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-25, 30, 33, 34 and 70-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Request for Continued Examination (RCE) and the amendment filed on August 7, 2006 have been entered. Accordingly:

- Claims 1-20, 26-29, 31, 32 and 35-69 have been canceled;
- Claims 21-23, 25, 30, 33 and 34 have been amended; and
- New claims 70-75 have been added.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Claim 34 (amended), lines 6-8, "a strut hingedly connected between the hub member and each rib member; wherein at least one of the light emitting diodes of the lighting system is carried by at least one of the struts".

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

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changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification lacks sufficient antecedent basis for the limitations of the amended dependent claim 34.

Neither the specification nor the figures provide any detail or description associated with the limitations "a strut hingedly connected between the hub member and each of rib members; wherein at least one of the LEDs of the lighting system is carried by at least one struts".

The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 21, 22, 24, 25 and 30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 102 and 107-110 of copending Application No. 10/829,790 in view of Pan et al. (US Patent No.: 6,439,249 B1).

The newly added claim 102, lines 1-19 and 24-31, of the copending application 10/829,790 meets all limitations, except the following, of claim 21 of the instant application. However, neither combined nor individually, the claims of the copending application recite "the LEDs being powered by the rechargeable power system without a need for connection to an AC power connection".

On the other hand, Pan et al. ('249 B1) discloses an outdoor umbrella apparatus (Figure 1) comprising:

- a lighting system including a plurality of light emitting diodes (LEDs) 5 collectively coupled – interpreted as all LEDs being coupled to one power system 11 – through the electrical cable 8 to the rechargeable power system 11 (Figure 1, column 3, lines 21-28); the electrical power system

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11 not requiring connection with an AC power outlet (Figure 1, column 3, lines 25-27).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the outdoor umbrella apparatus recited in claim 102 of the copending application 10/829,790 by providing the rechargeable power system powering the LEDs connection without needing connection with an AC power outlet as taught by Pan('249 B1) for the benefits of flexibility of locating the umbrella system at remote locations not having the AC power supply system.

Regarding claims 22, 24, 25 and 30, the copending application 10/829,790 in view of Pan ('249 B1) discloses the umbrella apparatus meeting the limitations as follows:

Copending application, claim 107, lines 1-3; in view of Pan ('249 B1) meets the limitations of the claim 22 of the instant application;

Copending application, claim 108, lines 1-4; in view of Pan ('249 B1) meets the limitations of the claim 24 of the instant application;

Copending application, claim 109, lines 1-3; in view of Pan ('249 B1) meets the limitations of the claim 25 of the instant application;

Copending application, claim 110, lines 1-3; in view of Pan ('249 B1) meets the limitations of the claim 30 of the instant application;

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not support the following limitations.

Claim 34, lines 6-8, " at least one of the light emitting diodes of a lighting system is carried by at least one of the struts".

Neither the specification nor the figures provide any detail or description reflecting "at least one strut carrying at least one of the LEDs". The specification includes following details that associates with the claimed rib members and lighting systems.

- a plurality of rib members preferably hingedly coupled to the pole portion (Page 7, lines 10 and 11; page 10, lines 17 and 18; page 14, lines 4-6; page 17, line);
 - an integral lighting system is carried by at least one of the rib members (Page 7, lines 11 and 12; page 10, lines 18-20; page 14, lines 6 and 7);
- and

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- a plurality of light strands attached to rib members (Page 7, lines 28 and 29; page 10, lines 25 and 26; page 14, lines 11 and 12).

The above details do not cover the limitation " at least one of the light emitting diodes of a lighting system is carried is carried by at least one of the struts," of the amended claim 34.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 21, 22, 23, 25, 33 and 70-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pan et al. (US Patent No.: 6,439,249 B1) in view of Small (US Patent No.: 2,960,094) hereinafter referred as Small.

Regarding claim 21, Pan et al. ('249 B1) discloses an outdoor umbrella apparatus (Figure 1) comprising:

- a pole portion 7 supportable by a support structure 10 for outdoor location (Figure 1, column 2, lines 49-51); an umbrella portion hingedly coupled to a pole portion 7 (Figure 1, column 2, lines 39-41); the umbrella portion including a plurality of rib members 3 (Figure 1, column 2, lines 41-51); the umbrella portion operable between open and close positions (Figure 1, column 2, lines 41-51); a rechargeable electrical power system 11 –

coupled to the electrical cable 8 (Figure 1) - electrically powering the umbrella apparatus (Figure 1, column 3, lines 25 and 26); a lighting system including a plurality of light emitting diodes (LEDs) 5 collectively coupled – interpreted as all LEDs being coupled to one power system 11 – through the electrical cable 8 to the rechargeable power system 11 (Figure 1, column 3, lines 21-28); the electrical power system 11 not requiring connection with an AC power outlet (Figure 1, column 3, lines 25-27); the plurality of LEDs 5 carried by the umbrella portion, and illuminating the area beneath the umbrella portion (Figure 1 and abstract); and a portion of the conductor 8 being carried by a rib – left upper rib - (Figure 1).

Although Pan et al. ('249 B1) discloses an outdoor umbrella apparatus, comprising a rechargeable power system as discussed above, Pan et al. ('249 B1) does not specifically teach the rechargeable system being charged with a solar energy system as claimed by the applicant.

On the other hand, Small discloses an outdoor umbrella device including a solar energy system including a solar collector 34 recharging a DC power source 35 – batteries – (Figure 1, column 2, lines 28-31); the solar collector 34 disposed above the umbrella portion 11 (Figure 1, column 1, lines 47-49; column 2, lines 28-31), the solar collector collecting and converting solar energy into electrical energy used for recharging the batteries 35 (Figure 1, column 2, lines 28-31); open and close positions of the umbrella does not affect the degree of exposure of the solar collector 28 (Figure 1).

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It would be have been obvious to one of ordinary skill in the art at the time of the invention to modify the umbrella apparatus of Pan et al. ('249 B1) by providing solar energy system for recharging the batteries as taught by Small for the benefits of cost saving resulting from the use of a least cost, renewable free energy source with high availability desired for reliable operation.

In addition, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus normally remains in outdoor locations in both open position and close position, and during after and during daylight hours (Pan, Figure 1, column 1, lines 40-43; column 2, lines 37-39).

Regarding Claim 22, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus comprising a rechargeable battery 35 positioned adjacent the solar energy system 34 (Small, Figure 1). Further, Small further teaches that the rechargeable batteries may be positioned either anywhere, including external or internal of the post (Small, Figure 1, column 2, lines 28-36).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Pan et al. ('249 B1) in view of Small by positioning the rechargeable batteries within the housing receiving the solar energy system, since it has been held that rearranging parts of a prior art structure involves only routing skill in the art. *In re Japikse*, 86 USPQ 70. Further, positioning of rechargeable power sources – batteries – within the housing receiving a solar energy system would operate well, and would be compact with less wiring.

Regarding Claim 23, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus comprising a solar energy system 34 carried in the first housing mounted on the top of the umbrella portion 11 (Small, Figure 1, column 1, lines 21-24; column 2, lines 28-30); and the rechargeable electrical power 35 received in a second housing within the post 10 (Small, not shown, column 2, lines 28-3).

Regarding Claim 25, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus comprising a support structure portion 10 adaptable for receiving the pole portion 7, and for supporting the umbrella apparatus during its outdoor positioning (Pan, Figure 1, column 2, lines 49-51).

However, neither in combination or individually Pan et al. ('249 B1) and Small teaches the support structure being removable.

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Pan et al. ('249 B1) in view of Small by making the support structure removable, since it has been held that making a component removable is a merely a matter obvious engineering choice, and involves only routine skill in the art. USPQ 348, 349 (CCPA 1961). Further, the umbrella apparatus with a removable support structure would operate equally well as that with a non-removable support structure. Provision of a removable support structure would facilitate relocation or disassembly of the umbrella apparatus.

Regarding claim 33, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus further comprising:

- a collapsible canopy, the collapsible position attained when the canopy is closed, (Pan, Figure 1, Column 2, lines 39-41); a lighting system, including a plurality of light emitting diodes (LEDs) 5, coupled to the to the collapsible canopy via ribs 3, and the lighting system illuminating the area beneath the umbrella portion (Pan, abstract, Figure 1, column 3, lines 2-5).

Regarding claims 70-75, Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus further comprising:

- the solar energy system 34 releasably coupled to the rechargeable electrical power system 35 – through the circuit cutout 33 – (Small. Figures 1 and 3, column 53-61);
- a top cap 1 for hingedly connecting the umbrella portion 3 to the pole 7 – the pole including the pole portion telescopically received on the lower portion of the pole 7 (Pan, Figure 1) and the rechargeable electrical power system including rechargeable batteries releasably coupled – removability of the batteries- to the top cap (Pan, Figure 1, column 3, lines 22-28);
- the solar energy system 34 and the rechargeable electrical power system 35 being positioned in separate housings casing of 34, and element 10 (Small, Figure 1); each of the rib members 3 is tubular allowing the light from the LEDs 5 to shine beneath the umbrella portion (Pan, Figures 1-4, column 3, lines 1-5; and abstract);

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- at least some of the LEDs 5 movable with articulation – movements of the ribs for closing and opening- of the umbrella (Pan, Figure 1); and
- a recessed channel 32 in each rib 3; and the channel 32 receiving at least a portion of the conductor 33 (Pan, Figure 1, column 2, lines 62-67).

10. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan et al. (US Patent No.: 6,439,249 B1) in view of Small (US Patent No.: 2,960,094) as applied to Claim 21 above, and further in view of Valdner (US Patent No. US 5,349,975).

Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus comprising a solar energy system conductively coupled to a rechargeable electrical power system as applied to claim 21 discussed in section 9 above. Further, Pan et al. ('249 B1) in view of Small teaches provision of an electrical receptacle switchably connectable to either conventional AC power supply, or to a rechargeable battery for powering lighting system (Pan, Figure 1, column 3, lines 25-30). However, neither combined nor individual teachings of Pan et al. ('249 B1) and Small specifically teaches recharging of the rechargeable batteries using AC power supply.

In the other hand, Valdner ('975) discloses an umbrella 10 (Figure 1) comprising a recharging system 54 – the combination including elements 14, 44, 54, 56 and 58 – electrically connectable to a rechargeable battery. The recharging system 54 is further connectable to a, AC power outlet (Figures 1, 3 and 8, column 2, lines 34-43).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Pan et al. ('249 B1) in view of

Small by the AC powered charging system for umbrella application as taught by Valdner ('975) for charging the rechargeable batteries when sunlight is either not available, or is available at marginal levels.

11. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pan et al. (US Patent No.: 6,439,249 B1) in view of Small (US Patent No.: 2,960,094) as applied to Claim 21 above, and further in view of Farr (US Patent Application Pub. No. US 2002/0078985 A1) hereafter referred as Farr.

Pan et al. ('249 B1) in view of Small discloses the outdoor umbrella apparatus comprising a solar energy system conductively coupled to a rechargeable electrical power system – rechargeable battery(s) -. However, neither in combination nor individually Pan et al. ('249 B1) and Small teaches the solar energy system being removably coupled to the rechargeable power system using a plug.

On the other hand, Farr discloses an umbrella device 10 (Figure 1) comprising a solar energy system 28 positioned above the umbrella portion 14; the solar energy system 28 removably coupled to a rechargeable battery 19 with the use of a plug 35 (Figures 1 and 2, Para. 0034, lines 19-23).

It would be have been obvious to one of ordinary skill in the art at the time of the invention to further modify the umbrella apparatus of Pan et al. ('249 B1) in view of Small by making the solar energy system removably coupled to the rechargeable batteries with the use of a plug as taught by Farr for the benefits of facilitating disassembly desired for replacement of parts including solar cells.

Response to Amendment

12. Applicant's arguments filed on August 7, 2006 with respect to the 35 U.S.C. 102(a) rejections of claims 21-24, 29 and 30; and 35 U.S.C. 103(a) rejections of claims 25-28, 31-34 have been fully considered but they are moot in view of the new ground(s) of rejections necessitated by the amendment.

In the non-final office action filed on April 4, 2006 included double patenting rejections of claims 21-34 over claims 78-92 of the copending application. However, the applicant has cancelled claims 78-92 of the copending application with the second preliminary amendment filed on August 24, 2006. Therefore, all arguments respective to the double patenting rejections of claims 21-34 of the instant application are moot.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hargobind S Sawhney whose telephone number is 571 272 2380. The examiner can normally be reached on 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571 272 2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

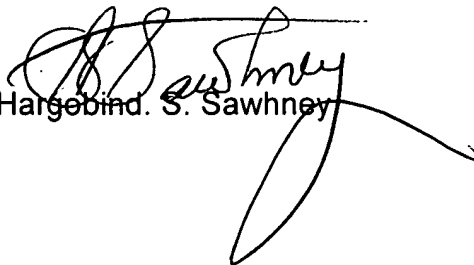
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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HSS

10/13/2006

Examiner: Hargebind. S. Sawhney

A handwritten signature in black ink, appearing to read "H. S. Sawhney", with a long, sweeping horizontal stroke extending to the right.